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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,052	02/05/2004	Joel B. Erickson	PU2172	2051

23454 7590 11/15/2005

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EXAMINER	
PASSANITI, SEBASTIANO	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,052	ERICKSON ET AL.	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *see detailed Office action*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/16/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 02/05/2004 – application papers filed; 09/16/2004 – IDS; 03/18/2005 – Status Letter.

Claims 1-18 are pending.

Following is an action on the MERITS:

Claim Objections

Claim 1 is objected to because of the following informalities:

In line 3, --a-- should follow "having".

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4 and 6-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,582,323 (Soracco et al). The claimed invention of the '323 Patent differs from the instant claimed invention in that the claimed invention of the '323 Patent does not include an aft-body composed of metal material, as required by claims 1, 6, 12, 14 and 16 and does not show an aft-body composed of injection-molded material, as required by instant claim 8. To have modified the claimed invention of the '323 Patent to incorporate metal material or injection-molded material for the aft-body would have been obvious to one of ordinary skill in the art at the time of the invention, since it has been held that the selection of a known material to take advantage of the desirable qualities of the known material would have been obvious to one of ordinary skill in the art. See **In re Hopkins** 145 USPQ 140.

With respect to the remaining limitations in the instant claims and with respect to instant claims 1, 11, 13 and 15, note that clam 1 of the '323 Patent details a face component made of a metal material (titanium alloy). Further, the '323 Patent includes the thickness ranges for the striking plate and the return portion and further includes the distance of the return portion extension, as further required by instant claim 1. The '323 Patent further includes the instant claimed coefficient of restitution. As for the instant claimed weight cavity, note that the '323 Patent includes a ribbon portion that is capable of holding weighting material, as indicated in claim 11 of the '323 Patent.

As to instant claim 2, see claim 2 of the '323 Patent.

As to instant claim 4, note claim 11 of the '323 Patent, wherein a weighting member of 10-100 grams is disclosed.

As to instant claim 7, see claim 5 of the '323 Patent.

As to instant claim 9, see claim 9 of the '323 Patent.

As to instant claim 10, see claim 10 of the'323 Patent.

As to instant claim 12 and concerning the required aft-body thickness and moment of inertia, see claim 11 of the '323 Patent.

As to instant claim 14 and concerning the required volume range, mass and aft-body thickness, see claims 11 and 14 of the '323 Patent.

Claim 3 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,582,323 (Soracco et al) in view of Noble ('596). To have modified the claimed invention of the '323 Patent to further include a striking face of variable thickness in order to selectively

strengthen or selectively provide weight to specific areas of the face would have been obvious in view of the patent to Noble, which shows it to be old in the art to incorporate a face wall of varying thickness to a metal wood-type club head in order to increase the thickness of the center of the face and provide reduced weight at the perimeter of the face to enhance the performance of the head (col. 3, line 51 through col. 4, line 5 in Noble).

Claims 5 and 16-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,582,323 (Soracco et al) in view of Mahaffey ('818) and Redman ('243). To have modified the claimed invention of the '323 Patent to include a means for altering the weight within a cavity portion of the head at all of the heel, toe and rear of the aft-body and to further provide a skid plate to cover the weights in order to selectively add weight to alter the moment of inertia of the head and to further help position and protect the weights would have been obvious in view of the patents to Mahaffey and Redman, each of which teaches that a wood-type club head may be provided with supplemental weighting at any of the toe, rear and heel portions of the head; said weights being provided and contained within a cavity; the cavity being closed by an appropriate cover member. For example, see cavities (124) with weights (126) held within housing (122) in Figure 4B of Mahaffey. Additionally, see Figures 5 and 6 and the weighting arrangement in Redman.

Further Comments on Double Patenting

It is noted that a similarly-styled obviousness-type double-patenting rejection may be set forth when comparing the claimed invention of U.S. Patent 6,739,982 with the

instant claimed invention. For purposes of brevity, the rejection will not be detailed, here. However, the Applicant is urged to review the claims of the '982 Patent and to maintain a clear line of demarcation between the claims of the '982 Patent and the instant claims. Alternatively, the Applicant may opt to file a second, separate terminal disclaimer in lieu of the '982 Patent.

Terminal Disclaimer

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

> The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

> II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior**

patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end MPEP § 1490.

Further Prior art of record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference to Butchart, detailed in the applicant's specification, is now made of record. Unlike the remaining references listed in the applicant's specification, this particular reference was not included on any of the IDS documents submitted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
November 11, 2005

Sebastiano Passaniti
Primary Examiner